

Appl. No. 10/092,068
Amendment Dated January 20, 2004
Reply to Office Action of November 17, 2003

REMARKS/ARGUMENTS

Claims 1 and 4-20 are pending in the above-identified application. Claims 2-3 and 21-28 have been canceled without prejudice herein.

I. Rejection Under 35 U.S.C. §112, second paragraph

Claims 4-9 were rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Specifically, the Examiner alleges that claims 4-9 are indefinite because the claimed second component of the binding reaction comprises a "non-protein molecule", yet dependent claim 4 states that the second component comprises a binding "fragment" of a full length protein. Applicants respectfully traverse.

The Examiner mistakenly reads claim 1 to require that the second component cannot have any amino acid residues, peptides, or proteins as part of its composition. This is not what Applicants intended, nor what the specification requires, by use of the term "non-protein molecule." As the specification makes plain at page 7, lines 22-29, the term "non-protein molecule" is intended to refer to any molecule other than a full length protein, including peptide probes, amino acid residues, and the like. Thus, claim 4, when read in conjunction with claim 1, makes sense in that it refers to a binding "fragment" of a full-length protein, e.g., a subset of "non-protein molecules". Thus, Applicants respectfully request that this rejection be obviated by the Examiner.

II. Rejections Under 35 U.S.C. §102(b)/103(a) and 103(a)

Claims 1 and 4-21 were rejected under 35 U.S.C. §102(b) as allegedly being anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over Oldenbourg et al. (U.S. Pat. 5,521,705) ("Oldenbourg"). Claims 1-22 and 25-27 were rejected under 35 U.S.C. §102(b) as allegedly being anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over Monks et al. (U.S. Pat. 6,022,700) ("Monks"). Claims 2-3, 22 and 25-27 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Oldenbourg as applied to claims 1 and 4-21 above and further in view of Monks.

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III. Claim Objections

Claims 23-24 and 28 were objected to because they were dependent upon a rejected independent base claim. In order to expedite prosecution of the instant application to allowance and issuance, Applicants have amended independent claim 1 to include all the limitations of allowable claim 28 and its intervening claims 27, 26, and 22. Dependent claims 19 and 20 have been amended slightly to correct some minor informalities which present no new matter. Thus, independent claim 1, as well as dependent claims 4-20 which depend therefrom (and thus include all the limitations of allowable claim 1), should now be allowable.

It should be noted that the cancellation, abandonment or amendment of any claim or any amendment in the description does not amount to abandonment of any subject matter in the application and upon any such cancellation, abandonment or amendment the right to file one or more continuing applications in respect of any subject matter in the application as filed is maintained.

Conclusion

For the foregoing reasons, Applicants believe all the pending claims are in condition for allowance and should be passed to issue. If the Examiner feels that a telephone conference would in any way expedite the prosecution of the application, please do not hesitate to call the undersigned at (650) 623-0667.

Respectfully submitted,



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